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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIHIRO DENDA and YOSHIYA NONAKA

Appeal 2009-002474
Application 10/058,788[1]
Technology Center 2100

Decided: September 23, 2009

Before JOSEPH L. DIXON, JAY P. LUCAS, and THU A. DANG, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Application filed January 30, 2002. Appellant claims the benefit under 35 U.S.C. § 119 of Japan application 2001-21803, filed 01/30/01. The real party in interest is Pioneer Corp.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1-10 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a system and method for appending title information to a recording of audio or video program material copied from a CD or downloaded from the communication network NET. In the words of Appellants:

> Information can be recorded in an easy-to-use form by appending title information thereto. When audio data is reproduced from an optical disc, such as a CD, and recorded into a hard disk, title information corresponding to the audio data is searched through a database region in the hard disk, and the retrieved title information is appended to the audio data and recorded into the storage region. When the corresponding title information is not retrieved, flag information indicating "no title information" is appended to the audio data so as to be recorded. When updated title information is provided by way of an optical disc or the like, by additionally recording the updated title information into the database region, the title information for the audio data indicated as "no title information" is automatically searched, and when the corresponding title information is found, the title information thus found is appended to the audio data and recorded into the storage region.

(Spec. 49, Abstract).

Claim 1 is exemplary:

> 1. An information recording and reproducing apparatus for recording program information reproduced from an information recording medium or program information supplied via a communication network into recording device, said apparatus comprising:

a first recording unit, provided in said recording device, for recording said program information reproduced from the information recording medium or said program information supplied via the communication network;

a second recording unit, provided in said recording device, for prerecording title information corresponding to said program information; and

control means for, when said program information is recorded into said first recording unit, (a) obtaining management information for managing said program information recorded in the information recording medium or supplied via the communication network, (b) in case that the title information corresponding to said program information is obtained by searching through said second recording unit based on the management information obtained, appending the title information obtained to said program information so as to be recorded into said first recording unit, and (c) in case that the title information corresponding to said program information is not obtained by searching through said second recording unit based on the management information obtained, appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Fujinami	US 6,385,152 B1	May 07, 2002
Matsumi	US 6,711,343 B1	Mar. 23, 2004

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1-10 stand rejected under 35 U.S.C. § 103(a) for being obvious over Matsumi in view of Fujinami.

Groups of Claims:
The claims will be considered together.

Appellants contend that the claimed subject matter is not rendered obvious by Matsumi in combination with Fujinami for failure of the references to teach a number of claimed limitations. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived.

We reverse the rejection.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether Matsumi teaches a recording unit in the recording device for recording title information prior to recording the related program information.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a device (and method) for recording onto a storage device, such as a hard drive, video, or audio, program information from a recording medium, such as a CD. (¶ [0001] and [0003]). In addition to the program material itself, the hard drive also records title information from a second storage unit in the recording device, or from the Internet, concerning the tracks of program information. (¶ [0019]). If no track information is available, that fact is so recorded. (¶ [0020]). The track information on the second storage unit may be updated from the Internet, even after the program material is recorded. (¶ [0059]). Also, the track information may be pre-recorded on the second storage unit prior to the program material being recorded on the storage device. (Spec. 47, bottom).

2. Matsumi teaches the recording of audio, video and auxiliary information from a digital video recording/reproducing device #256 to a hard disk #257. (Fig. 8, 32; Col. 24, ll. 47-57). The auxiliary information includes time of recording on cassette tapes, tape position information, cassette labels, file names and sizes. (Fig. 7; Col. 23, ll. 33-66). The auxiliary information may be added concurrently with the program information, or subsequent to the program information being recorded. (Col. 22, l. 23). If it has been already recorded, the auxiliary information need not be added. (Col. 22, l. 28). If the program material changes, then new auxiliary information is added. (Col. 27, ll. 16-33).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (citations omitted).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states that "the words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejection of Appellants'

claims under 35 U.S.C. § 103(a) on pages 3-15 of the Examiner's Answer. In opposition, Appellants present a number of arguments.

Arguments with respect to the rejection of claims 1 to 10 under 35 U.S.C. § 103(a) [R1]

Appellants present a plurality of arguments, but only one is dispositive of this appeal. Appellants state, "Thus, Matsumi fails to disclose or suggest a second recording unit for recording title information corresponding to said program information prior to recording said program information, as recited in independent claims 1, 5 and 8." (Brief 13, middle)

On first review, Appellants' argument seems credible. The auxiliary information recorded by Matsumi (*see* Fig. 7) that corresponds to Appellants' title information is uniformly derived and recorded concurrently with or subsequent to the recording of the program material. (FF#2, above). This is distinguished from the claimed invention where the title information is recorded prior to the program information, albeit on the second recording unit. The Examiner, however, has noticed that Matsumi's auxiliary information may be recorded (pre-recorded) for one set of program material, and the user may then choose to re-record different program material on that same tape. If a conventional recorder (not equipped to record auxiliary information) records the new program material, then when that tape is played in the Matsumi invention, new auxiliary information will be generated for the new material. (Col. 27, ll. 26-34). The Examiner has based the rejection on the presence of the older auxiliary information existing on the tape prior to the recording of the new program material. (Ans. 15,

bottom to 16, top). This is an interesting approach, but we do not find it applicable in the instant claimed invention. The claim clearly states "title information corresponding to said program information." In the Examiner's scenario, the title information corresponds to the previous program information and not the program information currently on the first recording unit. (Col. 27, l. 28). Thus, the rejection is based on an error of fact.

Since, as seen above, Appellants' argument is credible, we find error in the Examiner's rejection. The subject limitation is in all three of the independent claims, so the error extends to all of the claims.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 1-10.

DECISION

The Examiner's rejection of claims 1-10 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED

peb

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